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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,050	07/09/2004	Morag Hutcheon	66347-112	1661
7590 12/21/2005			EXAMINER	
Dykema Gossett Franklin Square Third West Floor 1300 I Street NW Washington, DC 20005-3306			DESAI, HEMANT	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/501,050	Applicant(s) HUTCHEON, MORAG	
	Examiner Hemant M. Desai	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-7 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/18/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is new matter, which was not described in the originally filed specification for example: "inserting a consumer product into the container, subsequently uploading to the memoryproduct", claim 1, lines 17-19). In the contrary applicant described in the specification that "The invention also includes a method of packaging a consumer product, the method comprising uploading digital data to the replaceable memory of a packaging container according to the first aspect of the invention through the input, inserting the product into the packaging container and thereafter sealing the container."

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoerg et al. (6338405).

Yoerg et al. discloses a method of packaging a consumer product (see col. 1, lines 57-60; col. 4, lines 25-35), the method comprising the steps of providing a container (10, fig. 1) having a housing and, disposed therein an audio integrated circuit (24, 26, fig. 2) capable of converting digital audio data into electrical audio signals (see col. 4, lines 47-55), a memory (28, fig. 4) connected to or integral with the audio integrated circuit for providing digital audio data to the audio integrated circuit, an input (52, 68, fig. 3) connected to the memory through which digital audio data can be uploaded to the memory, a transducer (60, 66, fig. 3) for receiving electrical audio signals from the audio integrated circuit and reproducing corresponding sound signals therefrom, a battery (56, fig. 2) connected to power the audio integrated circuit and the transducer, and a manually actuatable switch (38, 44, fig. 2) for causing the audio integrated circuit to operate to receive digital audio data from the memory and to provide electrical audio signals to the transducer for reproduction of audio material, inserting a consumer product (CD or DVD) into the container, and uploading to the memory, via the input terminal, digital data for output via the speaker (40, fig. 2) and pertaining to the contents of the consumer product (see col. 1, lines 54-67; col. 2, lines 1-3), which meets all the claimed limitations. Since Yoerg et al. disclose that the

information may be obtain about the content of the storage media without opening the protective case, it is inherent that the protective case is sealed.

Regarding claim 2, Yoerg et al. disclose that the flexibility of selecting different consumer product and digital data is selected correspondingly (see col. 3, lines 9-67).

Regarding claim 3, Yoerg et al. disclose that the integrated circuit chip is application specific.

Regarding claim 4, Yoerg et al. disclose that the consumer product is a CD or DVD (see col. 4, lines 25-35).

Regarding claim 5, Yoerg et al. disclose that the digital data comprises excerpts from each of the tracks on the CD (track selection button 34, figs. 1-2).

Regarding claim 6, Yoerg et al. disclose that the digital data comprises excerpts from the soundtrack of the DVD (see col. 4, lines 33-34).

Regarding claim 6, Yoerg et al. disclose that the input terminal comprises an RF transceiver.

Response to Arguments

5. Applicant's arguments filed 11/18/2005 have been fully considered but they are not persuasive.

In response to Applicant's argument that the Examiner has come to this conclusion only with the benefit of the disclosure of Yoerg, which discloses a protective case for a CD, but does not make any comment whatsoever on the method by which this CD product is manufactured and packaged. Note that Yoerg clearly discloses that the present invention relates to a method and device for encasing storage media and

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which contains means for reproducing and/or recoding messages regarding the storage media (see col. 1, lines 54-60). Yoerg, further discloses the steps of encasing the storage media in the protective case (see col. 1, lines 63-65) and means (24) for storing the data and second means for reproducing the recorded data (see col. 2, lines 1-3).

In response to Applicant's argument that the consumer product (i.e. CD) is inserted into the packaging before data is uploaded to the memory, note that this is new matter and is, as mentioned above, rejected under 35 U.S.C. 112, first paragraph. In the contrary applicant described in the specification that "The invention also includes a method of packaging a consumer product, the method comprising uploading digital data to the replaceable memory of a packaging container according to the first aspect of the invention through the input, inserting the product into the packaging container and thereafter sealing the container.", page 2, lines 30-35.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

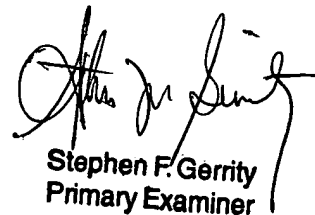
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hemant M. Desai whose telephone number is (571) 272-4458. The examiner can normally be reached on 7:00 AM-5:30 PM, Mon-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hemant M Desai
Examiner
Art Unit 3721

HMD



Stephen F. Gerrity
Primary Examiner